

### **REMARKS**

This Amendment is submitted in response to the Office Action dated September 22, 2004, having a shortened statutory period set to expire December 22, 2004. Claims 1-3, 8-10 and 18-20 have been amended. Claims 1-3, 8-10, 15 and 18-20 are currently pending.

#### **Claim objections**

At paragraph two, the Examiner has objected to Claims 2-3, 9-10, and 19-20 because of use of an indefinite article in positions at which a definite article is appropriate. Applicants have amended to correct these deficiencies, and Applicants thank the Examiner for his attention to detail.

#### **Claim Rejections under 35 U.S.C. § 102(e)**

At Paragraph 3 of the present Office Action, the Examiner has rejected Claims 1-2, 8-9, 15, and 18-19 under 35 U.S.C. 102(e) as being anticipated by United States Patent #6,600,622 B1 to Smith (*Smith*). Applicants respectfully submit that anticipation is established only when a single prior art reference discloses, either expressly or under the principles of inherency, each and every element of a claimed invention as well as disclosing structure which is capable of performing the recited functional limitations. *RCA Corp v. Applied Digital Data Systems, Inc.*, 730 F.2d 1440, 221 U.S.P.Q. 385 (Fed. Cir. 1984); *W.L. Gore and Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 U.S.P.Q. 303 (Fed. Cir. 1983). Applicants respectfully submit that *Smith* does not disclose all elements of Applicants' invention as recited in amended exemplary Claim 1, and Applicants respectfully traverse the Examiner's rejections, insofar as they might be applied to amended Claims 1-2, 8-9, 15, and 18-19.

Applicants' exemplary amended Claim 1 now recites "filtering and rectifying the position error signal amplitude to generate a sway mode signal amplitude indicative of an oscillation of the actual position of the magnetic head relative to the track centerline in a selected frequency range". Applicants have carefully examined *Smith* and respectfully submit that *Smith* does not teach or suggest a rectifying step or rectifying hardware. Because the rectifying step is not shown in *Smith*, Applicants respectfully submit that *Smith* does not anticipate amended exemplary Claim 1. Similarly, Applicants respectfully submit that *Smith* does not anticipate

amended Claim 2, which depends from and patentably distinguishes Claim 1, or similar Claims 8-9, 15, and 18-19.

Applicants further respectfully submit that, under 35 U.S.C. §103(c), *Smith*, having a common assignment with the present application, is not available as a reference for any rejection of the amended claims under 35 U.S.C. §103. M.P.E.P. § 706.02(k).

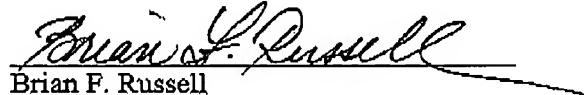
**Allowable Subject Matter**

At paragraph 5, the Examiner has objected to Claims 3, 10, and 20 as being dependent upon a rejected base claim and observed that the claims would be allowable if rewritten in independent form including all the limitations of the base claim and any intervening Claims. Applicants have amended Claims 3, 10, and 20 into independent form including all the limitations of the base claim and any intervening claims.

**Conclusion**

Applicants invite the Examiner to contact the undersigned attorney of record at (512) 343-6116 if such would further or expedite the prosecution of the present Application. No extension of time is believed to be required. However, in the event that an extension of time is required, please charge that extension fee and any other required fees to **Hitachi Corporation Deposit Account Number 50-2587**.

Respectfully submitted,



Brian F. Russell

Reg. No. 40,796

DILLON & YUDELL LLP

8911 North Capital of Texas Highway

Suite 2110

Austin, Texas 78759

Telephone (512) 343-6116

Facsimile (512) 343-6446

ATTORNEY FOR APPLICANTS